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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,774	12/20/2001	Damien R. Forkner	10012176-1	5672

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EXAMINER
VO, LILIAN

ART UNIT	PAPER NUMBER
2195	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/029,774	Applicant(s) FORKNER ET AL.	
	Examiner Lilian Vo	Art Unit 2195	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 26 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/09/06 has been entered.

Claim Objections

3. **Claims 5, 10, 15, 19, 22 and 25** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 5, 10, 15, 19, 22 and 25 each recites the limitation “wherein the persistent process performs background processing when there are no pending client requests” which merely repeating the limitation in their parent claims 1, 12 and 21.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 1 – 11 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.

The language of independent claim 11 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claim 1 does not appear to require any computer hardware to implement the claimed invention. The claim appears to define the metes and bounds of an invention comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of the claims. The "system" of claim 1 appears to be a system comprised entirely of software. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998). MPEP 2106. State Street required transformation of data by a machine before it applied the "useful, concrete, and tangible test." However, State Street does not hold that a "useful, concrete and tangible result" alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

Claims 1 – 11 are rejected under 35 U.S.C. 101 because the claimed invention, appearing to be comprised of software alone without claiming associated computer hardware required for

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execution, is not supported by either a specific and substantial asserted utility (i.e., transformation of data) or a well established utility (i.e., a practical application).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 – 3, 5 – 10, 12 – 19 and 21 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US 6,237,005) in view of Hockey (US Pat. Application Publication 2004/0064515).

8. Regarding **claim 1**, Griffin discloses a server (fig. 2) comprising:

an application (abstract and fig. 2), the application comprising:

a persistent process that generates dynamic and interactive HTML content for the application (abstract, col. 7 lines 1 - 18); and

a plurality of transient processes, wherein each transient process is launched to handle a client request from a client by parsing the client request, forwarding the client request to the persistent process, capturing a result from the persistent process and forwarding the result to the client (col. 3 lines 17 – 27, 58 – 65 and col. 11 lines 50 - 53);

wherein the persistent process performs background processing when no client requests are pending, the background processing including caching in memory (col. 8 lines 41 – 53 and col. 15 lines 41 – 60).

With respect to the limitation in which the persistent process performs background processing including caching in memory when no client requests are pending, Griffin discloses that the master interpreter (persistent process) "...is formed at time 1009 corresponding to a time prior to the receipt of the first transaction request message...The duration 1016 of the master interpreter 1002 extends from the time it was formed 1009 to an indefinite time in the future... the persistent nature of the master interpreter 1002 allows it to service multiple transaction requests." (col. 15 lines 41 – 48). Thus, it would have been obvious to one of an ordinary skill in the art, at the time the invention was made, to recognize that Griffin's master interpreter (persistent process) is performing the step of caching in the background while it is waiting for an incoming request. Furthermore, Hockey discloses the step of performing tasks in the background including caching and/or looking in the cache when there are no more messages waiting to be serviced (page 6, paragraph 104). Therefore it would have been obvious for one of an ordinary skill in the art, at the time the invention was made to incorporate Hockey's teaching with Griffin to perform other tasks while waiting so that resource can be utilized instead of being wasted and/or idle.

9. Regarding **claim 2**, as modified Griffin discloses the persistent process utilizes a support process outside the server (Griffin: col. 3 lines 50 - 56).

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10. Regarding **claim 3**, as modified Griffin discloses the transient processes implement a CGI (Griffin: col. 6 lines 2 - 6).

11. Regarding **claim 6**, as modified Griffin discloses that each of the plurality of transient processes terminates after forwarding the result to the client (Griffin: col. 3 lines 17 – 22 and col. 11 lines 50 - 53).

12. Regarding **claim 7**, as modified Griffin discloses when a first client sends a file request for a file, a first transient process obtains and forwards the file to the first client (Griffin: col. 7 lines 1 – 18).

13. Regarding **claim 8**, as modified Griffin discloses when a first client sends a file request for a file, a first transient process, after verifying access to the file, obtains and forwards the file to the first client (Griffin: col. 7 lines 1 – 18 and col. 9 lines 27 - 32).

14. Regarding **claim 9**, as modified Griffin discloses the plurality of transient processes communicate with the persistent process via interprocess communication (IPC) (Griffin: col. 6 lines 22 – 67 and figs. 5 - 6).

15. **Claims 5, 10, 12 – 19 and 21 - 25** are rejected on the same ground as stated in claims 1 – 3 and 6 - 9 above.

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16. Claims 4, 11, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US 6,237,005) in view of Hockey (US Pat. Application Publication 2004/0064515), as applied claims 1, 12 and 21 above, in view of Challenger et al. (US 6,026,413, hereinafter Challenger).

17. Regarding **claims 4 and 11**, as modified Griffin discloses that by maintaining master and pristine interpreters in memory for multiple transactions... the computer is able to service a larger number of users who are submitting these transactions during a high-usage, time period (Griffin: col. 4 lines 6 – 10). Therefore, it would have been obvious to one of an ordinary skill in the art, at the time the invention was made, that by servicing a larger number of users submitting the requests it implies that Griffin's system includes or uses a queue for the request. Furthermore, Challenger discloses the uses of a queue for storing the incoming requests (fig. 33a, 33B and 34). It would have been obvious for one of an ordinary skill in the art, at the time the invention was made, to incorporate this feature to modified Griffin's system so that incoming requests can be queued as they are waiting to be serviced accordingly in the order they were received.

18. **Claims 20 and 26** are rejected on the same ground as stated in claims 4 and 11 above.

Response to Arguments

19. Applicant's arguments with respect to claims 1, 12 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lilian Vo whose telephone number is 571-272-3774. The examiner can normally be reached on Thursday 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on 571-272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lilian Vo
Examiner
Art Unit 2195

lv
August 3, 2006


SUPERVISOR, PATENT EXAMINER
ART UNIT 2195